

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB  
6/25/99

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Bottorff

Opposition No. 106,556

Bernard Murphy

v.

Dieter Hafner

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB          JUNE 25,99

**Before Sams, Simms and Bottorff, Administrative Trademark  
Judges.**

**Opinion by Bottorff, Administrative Trademark Judge:**

Applicant, an individual citizen of Germany, has applied to register the mark PATNET for services recited as "legal services in the field of patent law; and intellectual property and technical searching services." The application, Serial No. 74/666,383, was filed April 27, 1995, and applicant claims priority under Trademark Act Section 44(d), 15 U.S.C. §1126(d), based on a German application filed on October 31, 1994.<sup>1</sup>

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<sup>1</sup> On April 26, 1995, applicant's German application matured to registration as No. 2905831.

Opposer filed a timely notice of opposition, alleging, as the ground of opposition, priority of use and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d). In the notice of opposition, opposer alleges that he is in the business of providing patent information, including patent copies, patent application file histories and pages therefrom, to others upon written, phone, fax or electronic medium requests, and in the business of filing papers for others in the United States Patent and Trademark Office; that he has used the mark PATNET in connection with such services since October 25, 1994, a date prior to applicant's October 31, 1994 Section 44(d) priority date; and that confusion is likely to result from applicant's use of the PATNET mark in connection with the services recited in applicant's application.

Applicant has filed an answer by which he denies the allegations of opposer's notice of opposition which are essential to opposer's Section 2(d) claim.

This case now comes up on opposer's motion for summary judgment on his Section 2(d) claim. The parties have fully briefed the motion. The evidence of record on summary judgment consists of the pleadings, the file of applicant's involved application, the declaration (and attached

exhibits) of opposer's witness Robert Genua,<sup>2</sup> and the declaration of applicant Dieter Hafner. See TBMP

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<sup>2</sup> Mr. Genua's declaration was attached to the notice of opposition, rather than to opposer's motion for summary judgment, but both parties have treated the declaration and its exhibits as being properly of record for purposes of opposer's summary judgment motion, and we shall do likewise.

§§528.05(a) and (b).

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A fact is genuinely in dispute if the evidence of record is such that a reasonable factfinder could return a verdict in favor of the nonmoving party. *Id.* In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. *See Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

As noted above, opposer's evidence on summary judgment consists of the declaration, with attached exhibits, of Mr. Robert Genua, who states that he is Vice President of Operations for FAXPAT, a corporation owned and controlled by, and which is asserted to be an assumed business name of, opposer Bernard Murphy, and which is authorized by Mr. Murphy to use his marks, including the PATNET mark. Mr. Genua states that FAXPAT uses the mark PATNET in connection with "legal research services, namely service of papers, filings and retrieval of legal papers and documents for others via electronic computer networks," and that FAXPAT's first use of the PATNET mark for such services was on October 25, 1994, at the AIPLA<sup>3</sup> Annual Meeting.

Exhibit A to Mr. Genua's declaration is a promotional brochure which is said to have been first distributed by opposer at the 1994 AIPLA meeting. It reads as follows, in relevant part:

**Introducing PatNet™**

Ordering and Tracking System for Windows®

Now you can save time and money ordering patent services from Faxpat® with PatNet™. A computer ordering and tracking system, PatNet™ reduces the amount of time you spend ordering patent services. As a bonus, all 3-5 day U.S. patents ordered during your first month's use of PatNet™ are only \$2 each.

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<sup>3</sup> The Board takes judicial notice that AIPLA is an acronym for the American Intellectual Property Law Association.

Available free of charge exclusively to Faxpat® customers, PatNet™ is a Windows®-based software program that's so easy to use, you'll be able to start ordering patent services the moment you install it on your PC. All you need to use PatNet™ is an IBM-compatible PC and modem with Windows® software.

Save yourself time ordering patent services. Eliminate the need for telephone follow-up to verify or check on orders. Take advantage of our \$2 patent special. Call today for your free PatNet™ program diskette or return the attached reply card. **800-866-1323.**

Exhibit B1 to the Genua declaration is a copy of the program diskette referred to in the last paragraph of the above-quoted promotional brochure. The PATNET mark appears on the diskette's label. Exhibit B to the Genua declaration is a printout of the home page for opposer's electronic worldwide bulletin board order system (BBS) which was first demonstrated at the 1994 AIPLA meeting. The screen appears as follows:<sup>4</sup>

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<sup>4</sup> Both the 1994 BBS screen (Exhibit B to the Genua declaration) and opposer's alleged current homepage screen (Exhibit E to the Genua declaration) reveal opposer's use of the federal registration symbol ® in connection with the PATNET mark. Such use is improper, inasmuch as opposer does not appear on this record to own any registration of the PATNET mark. See TMEP §906. Because applicant has not raised any issue in its answer to the notice of opposition or in its summary judgment brief with respect to opposer's improper use of the ® symbol, the Board shall give no consideration thereto in this proceeding. However, opposer is advised that it should discontinue its improper use of the ® symbol. See TMEP §906.01.

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Opposer argues that there is no genuine issue of material fact as to his priority, inasmuch as the earliest date upon which applicant may rely for priority purposes is the October 31, 1994 filing date of his German application, whereas opposer had made first use of his PATNET mark at the AIPLA Annual Meeting on October 25, 1994. Opposer also argues that there is no genuine issue of material fact as to the existence of a likelihood of confusion, contending that the parties' marks are identical; that applicant's services, as recited in applicant's application, overlap and encompass opposer's; and that the prospective customers for both parties' services are the same, i.e., the United States "patent community" of persons "interested in patent prosecution."

Applicant's evidence in opposition to opposer's motion for summary judgment consists of applicant's declaration, wherein he states, inter alia, that he is a German and European patent attorney; that he intends to use the PATNET mark in connection with the provision of legal services

"involving intellectual property matters in Europe and Germany" to persons in the United States; and that his services, unlike opposer's, "do not involve receiving orders for or procuring copies of documents from the United States Patent and Trademark Office."

Applicant initially argues that it would be premature to grant judgment to opposer in this case because opposer's motion for summary judgment was filed almost immediately after applicant's filing of his answer to the notice of opposition and before applicant had undertaken any discovery. This argument is unpersuasive, however, because applicant has failed to avail himself of the opportunity afforded him, under Fed. R. Civ. P. 56(f), to request leave to conduct any necessary discovery prior to responding on the merits to opposer's summary judgment motion. In view of such failure by applicant, the alleged absence of discovery is not a valid basis for denying opposer's summary judgment motion. See *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798-99 (Fed. Cir. 1989) ("A party may not simply assert in its brief that discovery was necessary and thereby overturn summary judgment when it failed to comply with the requirement of Rule 56(f) to set out reasons for the need for discovery in an affidavit.").



On the merits, applicant argues that opposer's motion for summary judgment should be denied because there are several genuine issues of material fact as to opposer's priority and as to the existence of a likelihood of confusion. With respect to priority, applicant contends that there is a genuine issue of material fact as to whether opposer's October 25, 1994 use of the PATNET mark at the AIPLA Annual Meeting was actually service mark use in connection with the document filing and retrieval services opposer has identified in the notice of opposition or whether, instead, opposer's use of the PATNET mark on that date and thereafter has been trademark use in connection with goods, i.e., a computer program. Applicant argues as follows:

To the extent that this use in connection with a computer program differs from the document retrieval and filing services covered by opposer's pending application, then this use may not even support a claim of priority in connection with the services as alleged in the Notice of Opposition. Indeed, since opposer has already allowed one application to register PATNET to go abandoned due to failure to submit specimens showing use of the mark in connection with services identified in the application, opposer may be going down the same path with respect to his current application.

(Applicant's summary judgment brief, at pp. 7-8.)<sup>5</sup>

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<sup>5</sup> Applicant here is referring to two applications filed by opposer for registration of the PATNET mark. Opposer alleged

As for likelihood of confusion, applicant argues that opposer's summary judgment motion should be denied because the parties' respective services are too dissimilar to support a finding of likelihood of confusion. At the very least, applicant argues, there is a genuine issue of material fact on this question. Specifically, applicant contends that opposer is in the business of retrieving and filing documents in the United States Patent and Trademark Office, whereas applicant "is providing legal services in the intellectual property field in Europe and Germany to persons in the United States," services which "will have nothing to do with the United States Patent and Trademark Office and in no event will they involve the retrieval and filing of documents in any jurisdiction." (Applicant's brief at p. 7.) Applicant also contends that there is a

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ownership of these applications in the notice of opposition, but the application files have not been made of record in this case. It appears from opposer's allegations and from the Office's automated records that opposer filed application Serial No. 74/706,352 on December 6, 1994, seeking registration of the PATNET mark for services recited as "legal research services, namely service of papers, filings, and retrieval of legal papers and legal documents for others via electronic computer networks"; that this application includes an allegation of October 25, 1994 as the date of first use of the mark anywhere and the date of first use of the mark in commerce; and that the application currently is suspended in the Trademark Examining Operation, presumably pending the outcome of this opposition proceeding against applicant's prior-pending application. It also appears that, on August 15, 1990, opposer had filed a previous intent-to-use application, Serial No. 74/088,104, to register the PATNET mark for services recited as "providing electronic transmission of legal documents for others". The Office declared that application abandoned on August 23, 1994 after opposer failed to file an acceptable statement of use with proper specimens

genuine issue of material fact as to whether opposer's document retrieval and filing services are, in fact, "legal research services," as alleged in opposer's declaration and in opposer's pending application for registration.

We have carefully considered the parties' arguments and evidentiary submissions. For the reasons discussed below, we find that no genuine issues of material fact exist either as to opposer's priority or as to the existence of a likelihood of confusion, and that opposer is entitled to judgment as a matter of law on his Section 2(d) claim.

There is no genuine issue of material fact as to opposer's priority. It is undisputed that the earliest date upon which applicant may rely, for priority purposes, is the October 31, 1994 filing date of his German application. Likewise, there is no dispute that opposer first used his PATNET mark on October 25, 1994, at the AIPLA Annual Meeting. Applicant argues that there is an issue of fact as to whether opposer's use of the mark on that date and thereafter has been service mark use in connection with opposer's document retrieval and filing services, or rather trademark use on a computer program. However, assuming *arguendo* that such a factual dispute exists, it is not a material issue of fact and thus it does not preclude entry

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demonstrating use of the mark in connection with the services recited in the application.

of summary judgment in favor of opposer in this case, for the following reasons.

Even if we were to accept applicant's premise that opposer's use of the PATNET mark since October 25, 1994 has been as a trademark on a computer program, rather than as a service mark in connection with opposer's services, there is no genuine dispute, on this record, that the computer program is inextricably intertwined with, and an adjunct to, opposer's document retrieval and filing services. It is apparent from opposer's promotional brochure, which is the only evidence of record on this issue, that the purpose or function of the computer program is to allow opposer's customers to order opposer's services, and to track their previous orders of opposer's services, via computer. Thus, it is immaterial whether opposer has used PATNET as a service mark for his document filing and retrieval services, or as a trademark for a computer program used in ordering opposer's document filing and retrieval services. In either case, we find that opposer, since a time prior to applicant's earliest priority date, has used the mark PATNET in connection with his document filing and retrieval services in a manner which establishes opposer's priority as a matter of law.<sup>6</sup>

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<sup>6</sup> We note that we need not and do not decide, in this proceeding, whether opposer's use of the PATNET mark, as shown by the evidence of record, constitutes technical service mark use

Having found that priority rests with opposer in this case, we turn next to the determination of whether a likelihood of confusion exists. In making that determination, we must take into account those of the *du Pont*<sup>7</sup> evidentiary factors as to which evidence has been submitted and which have been shown to be pertinent to this case. See *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989). The evidence of record in this case pertains only to the first and second *du Pont* factors, i.e., the similarity or dissimilarity of the parties' marks, and the similarity or dissimilarity of the parties' services.

It is undisputed that PATNET, the mark applicant seeks to register, is identical to the mark previously used by opposer. Thus, there is no genuine issue of material fact as to the first *du Pont* evidentiary factor, i.e., the similarity or dissimilarity of the marks in terms of appearance, sound, connotation and commercial impression. The identity of the parties' marks weighs heavily in favor of a finding of likelihood of confusion in this case.

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sufficient to entitle opposer to the service mark registration he has applied for in application Serial No. 74/706,352. Opposer's entitlement to such registration, *vel non*, is immaterial to the issue of whether opposer has established his Section 2(d) priority in this case, *vis-à-vis* applicant.

<sup>7</sup> *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The second *du Pont* evidentiary factor is the similarity or dissimilarity between the goods or services described in applicant's application and the goods or services in connection with which opposer has previously used his mark. To review, applicant's services, as recited in his application, are "legal services in the field of patent law, and intellectual property and technical searching services"; opposer's services, as established by opposer's Vice-President's affidavit, are "legal research services, namely service of papers, filings and retrieval of legal papers and documents for others via electronic computer networks."

Applicant argues that there is a genuine issue of material fact as to whether opposer's document retrieval and filing services are, as opposer claims, "legal research" services. For purposes of deciding opposer's summary judgment motion, we will resolve that factual issue in applicant's favor and assume that opposer's services, i.e., the filing and retrieval of documents in and from the United States Patent and Trademark Office for others, are not "legal research" services, within the common meaning of that term.

Applicant further argues that applicant's services are distinguishable from opposer's services because applicant's services are limited to consultation services in the field of German and European intellectual property matters, and

because applicant's services, unlike opposer's services, will not involve the filing and retrieval of documents from the U.S. Patent and Trademark Office. However, these purported limitations to the scope of applicant's services are not reflected in the recitation of services in applicant's application, and we can give them no consideration in our analysis under the second *du Pont* factor. See, e.g., *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

In any event, the issue is not whether applicant's services are distinguishable from opposer's services, but rather whether the parties' respective services are sufficiently closely related that source confusion is likely to result from the parties' use of their respective marks in connection with those services. See *Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985). It is well-settled that the parties' services do not need to be identical or even competitive in order to determine that there is a likelihood of confusion. Rather, it is sufficient that the parties' services be related in some manner or that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise, because of the marks used thereon, to the

mistaken belief that they originate from or are in some way associated with the same producer. *See, e.g., In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

Indeed, where the parties' marks are identical, as they are in the present case, it is only necessary that there be a viable relationship between the parties' goods or services in order to support a holding of likelihood of confusion. *See, e.g., In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

There is no genuine dispute that the parties' respective services are or will be marketed to the same potential customers, i.e., U.S. patent practitioners and other persons desiring patent information. We find that applicant's "legal services in the field of patent law, and intellectual property and technical searching services," though not identical to and perhaps not even competitive with opposer's document filing and retrieval services, are sufficiently closely related to opposer's services that, when they are offered under the same mark, i.e., PATNET, the parties' potential customers are likely to mistakenly assume that the respective services originate from a single source or that some sponsorship connection or other affiliation



exists between the providers of the services. No reasonable factfinder could conclude otherwise.

Thus, we find that there is no genuine issue of material fact that the parties' respective services are similar, rather than dissimilar, under the second *du Pont* evidentiary factor. This factor, like the first *du Pont* factor, weighs in favor of a finding of likelihood of confusion in this case.

In short, we find that there are no genuine issues of material fact as to any of the relevant *du Pont* factors, and that the evidence of record pertaining to those evidentiary factors establishes that a likelihood of confusion exists in this case. Having also found that there are no genuine issues of material fact as to opposer's priority, we conclude that opposer is entitled to judgment as a matter of law on its Section 2(d) ground of opposition. Accordingly, opposer's motion for summary judgment is granted. See Fed. R. Civ. P. 56(c). The opposition is sustained, and registration to applicant is refused.

J. D. Sams

R. L. Simms

C. M. Bottorff

Opposition No. 106,556

Administrative Trademark Judges  
Trademark Trial and Appeal Board